

DOCKET NO.: MSFT-0180/138333.1

# 1862  
7-9-03  
PATENT *ml*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Vijay K. Gajjala et al.

Application No.: 09/671,055

Filing Date: September 28, 2000

For: Retail Transactions Involving Digital Content In A Digital Rights Management (DRM) System

Confirmation No.: 7632

Group Art Unit: 3621

Examiner: Le, David Q.

DATE OF DEPOSIT: June 27, 2003

I HEREBY CERTIFY THAT THIS PAPER IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID, ON THE DATE INDICATED ABOVE AND IS ADDRESSED TO THE COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450.

*Steven H. Meyer*  
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REGISTRATION NO.: 37,189

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

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GROUP 3600

Transmitted herewith for filing in the above-identified patent application is:

- ☐ A Preliminary Amendment.
- ☒ An Amendment Responsive to the Office Action Dated March 31, 2003.
- ☐ An Amendment Supplemental to the Paper filed
- ☐ Other:
- ☐ Applicant(s) has previously claimed small entity status under 37 CFR § 1.27.

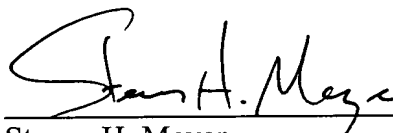
- ☐ Applicant(s) by its/their undersigned attorney, claims small entity status under 37 CFR § 1.27 as:
- ☐ an Independent Inventor
  - ☐ a Small Business Concern
  - ☐ a Nonprofit Organization
- ☐ This application is no longer entitled to small entity status. It is requested that this be noted in the files of the U.S. Patent and Trademark Office.
- ☐ Loss of Entitlement Enclosed
- ☐ Substitute Pages            of the Specification are enclosed.
- ☐ An Abstract is enclosed.
- ☐            Sheets of Proposed Corrected Drawings are enclosed.
- ☐ A Certified Copy of each of the following applications:            is enclosed.
- ☐ An Associate Power of Attorney is enclosed.
- ☐ Information Disclosure Statement.
- ☐ Attached Form 1449.
  - ☐ A copy of each reference as listed on the attached Form PTO-1449 is enclosed herewith.
- ☐ Appended Material as follows:            .
- ☐ Other Material as follows:            .

## FEE CALCULATION

- ☒ No Additional Fee is Due.
- ☐ Petition is hereby made under 37 CFR § 1.136(a) (fees: 37 CFR § 1.17(a)(1)-(4) to extend the time for response to the Office Action of \_\_\_\_\_ to and through \_\_\_\_\_ comprising an extension of the shortened statutory period of \_\_\_\_\_ month(s).
- ☒ The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is further authorized to charge any fees related to any such extension of time to Deposit Account 23-3050. This sheet is provided in duplicate.
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 23-3050. This sheet is provided in duplicate.
- ☐ The foregoing amount due for filing this paper.
- ☒ Any additional filing fees required, including fees for the presentation of extra claims under 37 CFR § 1.16.
- ☒ Any additional patent application processing fees under 37 CFR § 1.17 or 1.20(d).

**SHOULD ANY DEFICIENCIES APPEAR** with respect to this application, including deficiencies in payment of fees, missing parts of the application or otherwise, the U.S. Patent and Trademark Office is respectfully requested to promptly notify the undersigned.

Date: June 27, 2003

  
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TYPED NAME: Steven H. Meyer  
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Sir:

REPLY PURSUANT TO 37 CFR § 1.111

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In response to the Official Action dated **March 31, 2003**, reconsideration is respectfully requested in view of the amendments and/or remarks as indicated below:

- ☐ **Amendments to the Specification** begin on page \_\_\_\_\_ of this paper.
- ☐ **Amendments to the Claims** are reflected in the listing of the claims which begins on page \_\_\_\_\_ of this paper.
- ☐ **Amendments to the Drawings** begin on page \_\_\_\_\_ of this paper and include an attached replacement sheet.
- ☒ **Request for Reconsideration** begin on page 2 of this paper.

### REQUEST FOR RECONSIDERATION

The following Request for Reconsideration is being submitted in response to the Office Action mailed on March 31, 2003 (Paper No. 6) in connection with the above-identified application and is being filed within the three-month shortened statutory period set for a response to the Office Action.

Claims 1-66 are pending in the present application. All claims stand rejected. Applicants respectfully request reconsideration and withdrawal of the rejection of the claims consistent with the following remarks.

The Examiner has rejected claims 1-66 under 35 USC § 103(a) as being obvious over Stefik et al. (U.S. Patent No. 5,634,012) in view of Ginter et al. (U.S. Patent No. 5,892,900) and further in view of Biddle et al. (U.S. Patent Application Publication No. 2002/0107809). Applicants respectfully traverse the § 103(a) rejection.

Preliminarily, Applicants respectfully submit that the § 103(a) rejection is prima facie improper for the reason that the Examiner has failed to specifically point out how the cited references make the claims obvious. For example, and with regard to the rejection of independent claims 1, 23, and 45, the Examiner briefly sets forth a general appraisal of what each of the cited references discloses, and then, without more specific analysis, concludes that it would have been obvious to combine the teachings of the references to arrive at the subject matter claimed.

The Examiner does take care to reproduce versions of the independent claims, but fails in connection therewith to cite to specific parts of the references to show how every element is disclosed or suggested. For example, with regard to claims 1, 23, and 45, the

Examiner fails to cite to any reference that would disclose or suggest “composing, by the retailer, an actual license request including the obtained customer-based information, and including retailer-based information identifying the retailer to the licensor and acknowledging to the licensor that the retailer owes a portion of the received payment to the licensor”.

Similar examples abound with regard to all other rejected claims.

Applicants respectfully submit that the Examiner’s failure to point out the rationale for the rejection with specificity amounts to a blanket rejection of the claims that cannot satisfy the requirement that the Examiner make a prima facie case of obviousness under Section 103(a). In particular, Applicants respectfully point out that such a blanket rejection of the claims without providing any specific details does not at all provide any indication of why the cited references should or could be combined to produce the invention recited in the claims.

That said, Applicants note that independent claim 1 recites a method for a retailer to facilitate issuance of a digital license from a licensor to a customer for a corresponding piece of digital content. In the method, the retailer receives from the customer payment for the license, where the payment is to be shared with the licensor in a pre-determined manner. The retailer obtains from the customer customer-based information and composes an actual license request, which includes the obtained customer-based information and retailer-based information identifying the retailer to the licensor and acknowledging to the licensor that the retailer owes a portion of the received payment to the licensor. The retailer then forwards to the licensor the actual license request.

Independent claim 23 recites similar subject matter, although in terms of a computer, and independent claim 45 also recites similar subject matter, although in terms of a computer-readable medium.

Independent claim 16 recites a method for a licensor to issue a digital license to a customer for a corresponding piece of digital content, where the customer has forwarded payment for the license to a retailer. The payment is to be shared with the licensor in a pre-determined manner. In the method, the licensor receives from the retailer an actual license request as composed by the retailer, where the actual license request includes customer-based information obtained from the customer, and includes retailer-based information identifying the retailer to the licensor and acknowledging to the licensor that the retailer owes a portion of the received payment to the licensor. Based on the retailer-based information, the licensor notes that the retailer identified thereby owes the licensor at least a portion of the forwarded payment.

Independent claim 38 recites similar subject matter, although in terms of a computer, and independent claim 60 also recites similar subject matter, although in terms of a computer-readable medium.

Thus, claims 1, 23, and 45 represent the license request from the retailer to the licensor on behalf of the customer from the point of view of the retailer which sold the content to customer, while claims 16, 38, and 60 represent the license request from the point of view of the licensor that is to issue the actual license.

The Stefik reference discloses a system for controlling use and distribution of digital works. The system is exemplified by multiple repositories wherein the digital works are

stored and accessed from such repositories, and are transferred only between such repositories. Each repository is a trusted system and can operate in a requestor mode for requesting a digital work from another repository and a server mode for responding to a request from another repository. Importantly, and as disclosed beginning at column 9, line 20, usage rights (i.e., a license with license terms) are attached to digital works in the Stefik system, and both the work and its attached license are transmitted from a serving repository (at a content provider, e.g.) to a requesting repository (at a client, e.g.). See also Fig. 1 and column 7, lines 16-48. Accordingly, the Stefik reference does not disclose or suggest a license separate from a digital work.

More particularly, Applicants respectfully submit that the Stefik reference does not disclose or suggest that a retailer receive from a customer payment for a license, where the payment is to be shared with a licensor in a pre-determined manner, as is required by claims 1, 23, and 45 and as is required by claims 16, 38, and 60, or that the retailer compose an actual license request, which includes obtained customer-based information and retailer-based information identifying the retailer to the licensor and acknowledging to the licensor that the retailer owes a portion of the received payment to the licensor, as is also required by claims 1, 23, and 45 and as is required by claims 16, 38, and 60.

The Ginter reference discloses, in profuse detail, a system for electronic commerce where content is securely transmitted and rendered in a rights-enforced manner. However, Applicants after having reviewed the voluminous disclosure of the Ginter reference can find no disclosure or suggestion that the Ginter reference has incumbent therein a retailer that receives from a customer payment for a license, where the payment is to be shared with a licensor in a pre-determined manner, as is required by claims 1, 23, and 45 and as is required

by claims 16, 38, and 60, or that the retailer composes an actual license request, which includes obtained customer-based information and retailer-based information identifying the retailer to the licensor and acknowledging to the licensor that the retailer owes a portion of the received payment to the licensor, as is also required by claims 1, 23, and 45 and as is required by claims 16, 38, and 60.

The Biddle reference discloses a system for managing licensing data where a distributor 25 and a vendor 40 work together to distribute software to a user 30. However, and again, Applicants after having reviewed the disclosure of the Biddle reference can find no disclosure or suggestion that the Biddle reference has incumbent therein a retailer that receives from a customer payment for a license, where the payment is to be shared with a licensor in a pre-determined manner, as is required by claims 1, 23, and 45 and as is required by claims 16, 38, and 60, or that the retailer composes an actual license request, which includes obtained customer-based information and retailer-based information identifying the retailer to the licensor and acknowledging to the licensor that the retailer owes a portion of the received payment to the licensor, as is also required by claims 1, 23, and 45 and as is required by claims 16, 38, and 60.

Accordingly, Applicants respectfully submit that none of the Stefik, Ginter, and Biddle references discloses or suggests a retailer that receives from a customer payment for a license, where the payment is to be shared with a licensor in a pre-determined manner, as is required by claims 1, 23, and 45 and as is required by claims 16, 38, and 60, where the retailer composes an actual license request which includes obtained customer-based information and retailer-based information identifying the retailer to the licensor and acknowledging to the licensor that the retailer owes a portion of the received payment to the

licensor, as is also required by claims 1, 23, and 45 and as is required by claims 16, 38, and 60. Thus, Applicants respectfully conclude that such Stefik, Ginter, and Biddle references cannot be applied to make obvious claims 1, 23, and 45 and claims 16, 38, and 60 or any claims depending therefrom.

Independent claim 20 recites a method for a licensor to respond to a license request from an individual for a corresponding piece of digital content, as with claim 16. Here, the individual has failed to forward payment for the license to a retailer. That is, the individual has attempted to obtain the license directly from the licensor without going through the retailer as in claims 1 and 16. In the method, the licensor receives from the individual an actual license request as composed by the individual. The actual license request includes customer-based information but fails to include retailer-based information identifying a retailer to the licensor and acknowledging to the licensor that a retailer owes a portion of any received payment to the licensor, as with claims 1 and 16. Thus, the licensor refuses based on the lack of retailer-based information to issue a license as requested.

Independent claim 42 recites similar subject matter, although in terms of a computer, and independent claim 64 also recites similar subject matter, although in terms of a computer-readable medium.

Quite simply, none of the Stefik, Ginter, and Biddle references even considers a situation where an individual has failed to forward payment for a license to a retailer but instead has attempted to obtain the license directly from the licensor without going through the retailer. Accordingly, none of such references discloses or suggests that in the situation where the licensor receives from the individual an actual license request as composed by the

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individual, where the actual license request includes customer-based information but fails to include retailer-based information identifying a retailer to the licensor and acknowledging to the licensor that a retailer owes a portion of any received payment to the licensor, the licensor should or could refuse based on the lack of retailer-based information to issue the requested license, all as required by claims 20, 42, and 62.

Accordingly, Applicants respectfully submit that none of the Stefik, Ginter, and Biddle references discloses or suggests the invention recited in claims 20, 42, and 64. Thus, Applicants respectfully conclude that such Stefik, Ginter, and Biddle references cannot be applied to make obvious claims 20, 42, and 64 or any claims depending therefrom.

For all of the aforementioned reasons, then, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection.

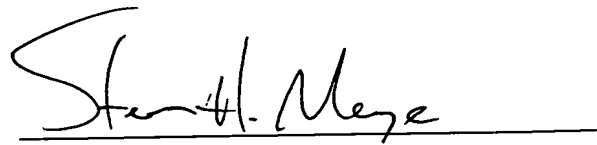
Applicants note that the Examiner has not acknowledged acceptance of the formal drawings filed with the application. Accordingly, Applicants respectfully request such acknowledgment in the next Communication from the Patent Office.

In view of the foregoing discussion, Applicants respectfully submit that the present application, including claims 1-66 is in condition for allowance, and such action is respectfully requested.

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Date: June 27, 2003

A handwritten signature in black ink, appearing to read "Steven H. Meyer", is written over a horizontal line.

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